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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Tordera

Serial No.: 09/839,059

Filed: April 20, 2001

For: PDA CRADLE FOR WIRELESS IP
COMMUNICATION

Art Unit: 2685

Examiner: Phan

50R4628

May 31, 2004
750 B STREET, Suite 3120
San Diego, CA 92101RESPONSE TO OFFICE ACTIONCommissioner of Patents and Trademarks
Washington, DC 20231

Dear Sir:

The following remarks are submitted in response to the Office Action dated May 6, 2004. Claims 1-5 and 8-12 have been rejected under 35 U.S.C. §103 as being obvious over Bernard in view of Dent, Claims 13-21 and 27 have been rejected as being obvious over Bernard in view of Kay, and Claims 22-26 and 28 have been rejected as being obvious in view of Bernard.

The independent claims are 1, 13, and 22, all of which are directed to a portable computer cradle that has wireless transmission capability. In Claim 1, the cradle must have a directional antenna, structure not taught in Bernard; in Claim 13, it must operate in a frequency band not taught in Bernard; and in Claim 22 the portable computer must display an icon representing the cradle, something the examiner admits is not taught in Bernard.

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With the above summary in mind and first considering the rejection of Claim 1, the examiner proposes to incorporate the directional antenna of Dent into Bernard on the rationale that using Dent in Bernard would improve the "quality and reliability" of Bernard. This is incorrect. The reason Dent teaches use of a directional antenna is to transmit to a satellite. Bernard does not transmit to a satellite, but rather appears to use conventional terrestrial wireless systems that in fact typically require directionless antennas to work as intended. At most, Bernard can receive positional information from a GPS satellite but neither Dent nor Bernard indicates that this requires a directional antenna, in contrast to the satellite transmitting function of Dent. Consequently, because Bernard does not perform the function which requires the directional antenna in Dent and indeed appears to use conventional terrestrial systems that teach away from directional antennas, there is no prior art reason to use a directional antenna in Bernard. The mere fact that both happen to be "related to the communication interface device" is insufficient legal basis to combine. Just because two references happen to be in the same filed of endeavor is insufficient reason to combine the references unless the *prior art* suggests the combination, MPEP §2143.01. The rejection of Claim 1 has been overcome.

With respect to Claim 13, the proposed modification of Bernard to use the frequency band of Kay likewise fails to find support in the prior art. Kay uses its frequency for communicating between subscriber (and explicitly non-mobile) terminals and a central terminal, an application that Kay nowhere indicates has any relevance in portable computer cradles. The subscriber terminals in Kay are hard wired to their telephones, with the point of Kay being to provide a wireless infrastructure for an otherwise conventional public telephone system having non-mobile wired telephones. Nowhere does Bernard suggest that systems such as Kay's bear any relevance to portable computer cradles, and nowhere does Kay suggest that its

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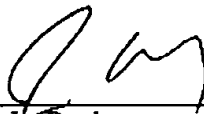
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frequency band is appropo for portable computer cradles. The mere fact that two references happen to exist in the same field, as mentioned above, is simply not sufficient legal basis for combining the references under MPEP §2143 (see in particular the discussion of In re Mills, stating that the "mere fact that references can be combined is insufficient reason absent *prior art* suggestion to do so").

The rejection of Claim 22 is even easier to overcome, because here, the limitation of displaying, on the computer, an icon representing the cradle is missing from the prior art altogether as admitted by the examiner, otherwise rendering the claim patentable (MPEP §2142 *et seq.* requires that to establish a *prima facie* case of obviousness, all claim limitations must be shown to appear in the prior art). The legal error committed in the rejection is the observation that because computers are known to display icons, the *particular, untaught* icon of Claim 22 is thereby rendered obvious, without a shred of prior art evidence to support this allegation. Because the rejection of Claim 22 so plainly runs afoul of the requirements of the MPEP, in all likelihood it would be reversed on appeal.

The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

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